

REMARKS

[0001] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1, 2, 4-22 and 24-31 are presently pending. Claims 12 and 18 are amended herein. No claims are withdrawn or cancelled herein. New claims 29-31 are added herein.

Formal Request for an Interview

[0002] If the Examiner's reply to this communication is anything other than allowance of all pending claims and the only issues that remain are minor or formal matters, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0003] Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

Claim Amendments and Additions

[0004] Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims herein. Applicant amends claims to highlight claimed features. Such amendments are made to expedite prosecution by emphasizing the claimed features, and should not be construed as further limiting the claimed invention in response to the cited documents.

[0005] Claim 12 is amended to highlight subject matter from dependent claim 18, and claim 18 is amended solely to address antecedent basis.

[0006] Furthermore, Applicant adds new claims 29-31 herein. These new claims are fully supported by Application and therefore do not constitute new matter.

[0007] New dependent claims 29-30 are allowable over the cited documents for at least the same reasons that claims 1 and 24 are allowable because the new claims depend from and incorporate the allowable features of claims 1 and 24 as discussed below. New independent claim 31 is allowable over the cited documents for at least the same reasons that claim 24 is allowable because the new claim incorporates the allowable features of claim 24 as discussed below.

Substantive Matters

Claim Rejections under 35 U.S.C. § 102 and § 103

[0008] The Office rejects claims 20-22 and 26-28 under § 102(a). Applicant respectfully traverses these rejections. In addition, the Examiner rejects claims 1-2, 4-11, 12-19 and 24-25 under § 103. Applicant respectfully traverses these rejections. For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious.

[0009] Accordingly, Applicant respectfully requests that the § 102 and § 103 rejections be withdrawn and the case be passed along to issuance.

Declarations and Exhibits

Previously Submitted Declarations and Exhibits

[0010] Applicant refers the Office to the Declarations of Maples, De Heer, Brant, and Ludvig with associated exhibits A-P filed December 29, 2008 and January 22, 2009. These declarations and exhibits are incorporated by reference herein.

37 C.F.R. 1.131 Declaration Regarding Prior Invention

[0011] Applicant herewith submits a declaration under 37 CFR 1.131 and accompanying exhibits Q and R. Exhibit Q is a true and complete copy of the "First Draft" of the instant application sent to the inventors for review on January 7, 2004 as shown in Exhibit G. Exhibit Q includes a draft of each part of the application: title, abstract, claims, background, summary, brief description of and corresponding figures, and detailed description with drafting agent comments redacted. Exhibit R contains the instant pending claims mapped to Exhibit Q evidencing the fact that the inventor was in possession of the subject matter of the instant claims before February 24, 2004.

37 C.F.R. 1.132 Declaration Regarding Public Availability of *Zigmond*

[0012] Additionally, Applicant herewith submits a declaration under 37 CFR 1.132 attesting to the fact that the subject matter of the application that matured to become *Zigmond* was not publicly available until issuance, February 24, 2004. Accordingly, *Zigmond* qualifies under 35 U.S.C. § 102(e) rather than 35 U.S.C. § 102(a).

[0013] Therefore, Applicant respectfully asserts that the evidence, taken as a whole, demonstrates that *Zigmond* became publicly available after invention by the Applicant of the subject matter of the instant application, and is properly accorded an effective date of February 24, 2004 under 35 U.S.C. § 102(e).

CITED ART SUBJECT TO OBLIGATION OF ASSIGNMENT TO SAME
ASSIGNEE – 35 U.S.C. § 103 (C)

[0014] Applicant respectfully requests that the Examiner remove U.S. Patent No. 6,698,020 to *Zigmond* as a prior art reference in rejections based on 35 U.S.C. § 103, and withdraw the rejections pending under 35 U.S.C. § 103 in prosecution of the instant application as a result of the following statement as set forth in the Manual of Patent Examining Procedure, 706.02(I)(2) II.

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

[0015] The instant application and the cited reference, U.S. Patent No. 6,698,020, to *Zigmond*, at the time the invention of the instant application was made, were commonly owned by Microsoft Corporation. Applicant respectfully submits that the cited reference, U.S. Patent No. 6,698,020, only qualifies as prior art under § 102(e), and shared a common owner with the instant application at the time the subject matter of the instant application was conceived. Thus, U.S. Patent No. 6,698,020, to *Zigmond* cited in combination with *Eldering*, US Patent No. 6,216,129, under § 103(a) should be disqualified under § 103(c).

Overview of the Application

[0016] The Application describes a technology for targeting advertisements based on consumer purchasing data. Profiles are generated for broadcast television system subscribers based on consumer purchasing data maintained, for example, by retail and service providers. A particular advertisement is targeted by associating the advertisement with one or more characteristics from a consumer profile which also identifies client devices associated with consumers. A client device is configured to receive a message indicating an upcoming targeted advertisement, compare locally stored subscriber profile data with the profile characteristics associated with the targeted advertisement, and determine whether to tune to the targeted advertisement or to allow the default advertisement to be rendered.

Cited Documents

[0017] The Examiner cites *Zigmond* as the primary reference and *Eldering 129* as the secondary reference in several obviousness-based rejections. In other obviousness-based rejections the Examiner cites *Eldering* as the primary reference with *Aras* as the secondary reference, *Eldering 129* as a tertiary reference, and *Saam* as a quaternary reference.

- **Zigmond:** *Zigmond, et al.*, US Patent No. 6,698,020 (issued February 24, 2004); describes a technology for selecting and inserting advertisements into a video programming feed at the household level.
- **Eldering 129:** *Eldering*, US Patent No. 6,216,129 (issued April 10, 2001); describes an advertisement selection system of vectors describing an actual or hypothetical market for a product or desired viewing audience.

- **Eldering:** *Eldering, et al.*, US Patent Application Publication No. 2004/0148625 (Published July 29, 2004); describes an ad management system (AMS) for managing sales and insertion of targeted advertisements into advertising opportunities.
- **Aras:** *Aras, et al.*, US Patent No. 5,872,588 (issued February 16, 1999); describes content coding of Audio-Visual materials.
- **Saam:** *Saam*, US Patent Application Publication No. 2003/0106070 (Published June 5, 2003); describes efficient customization of advertising programs for broadcast TV.

Anticipation Rejections

[0018] The Examiner rejects claims 20-22 and 26-28 under 35 U.S.C. § 102(a) as being anticipated by *Zigmond*. Applicant respectfully traverses the rejection of these claims. Applicant asks the Examiner to withdraw the rejection of these claims.

[0019] 35 U.S.C. § 102(a) and (e) state:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[0020] *Zigmond* does not qualify under 102(a). As evidenced in the declarations and corresponding exhibits filed December 29, 2008, January 22, 2009, and herewith, *Zigmond* was not known by others or patented or described in a printed publication before the instant invention by the Applicant, and *Zigmond* was published after invention of the subject matter of the instant application by the Applicant.

[0021] Exhibits A, B, and C clearly show that WebTV Networks, Inc. and all of the assets of WebTV Networks, Inc., including the application that matured to become *Zigmond* were owned by Microsoft Corporation at the date of filing, June 15, 1998.

[0022] Furthermore, Applicant submits herewith a declaration under 37 CFR 1.131 and accompanying exhibits illustrating the fact that the inventor was in possession of the subject matter of the instant claims before February 24, 2004. Exhibit Q is a true and complete copy of the first draft of the instant application sent to the inventors for review on January 7, 2004 with the drafting agent's comments redacted, and exhibit R contains the instant pending claims mapped to Exhibit Q.

[0023] Moreover, Applicant herewith submits a declaration under 37 CFR 1.132 attesting to the fact that the subject matter of the application that matured to become *Zigmond* was not publicly available until issuance, February 24, 2004. Accordingly, *Zigmond* qualifies under 35 U.S.C. § 102(e) rather than 35 U.S.C. § 102(a).

[0024] Applicant respectfully asserts that based on the totality of evidence presented and pursuant to the date evidence of record, *Zigmond* must not be accorded status of a 35 U.S.C. § 102(a) reference regarding the dates associated with the instant application. Accordingly, Applicant asks the Examiner to withdraw the 35 U.S.C. 102(a) rejections of claims 20-22 and 26-28.

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0025] The Examiner rejects claims 1-2, 4-11 and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over *Zigmond*. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims. In light of the discussion presented herein and the exhibits and declarations submitted herewith and of record, Applicant submits that these rejections are moot.

[0026] The Examiner rejects claims 12-19 under 35 U.S.C. § 103(a) as being unpatentable over *Eldering* in view of *Aras* and further in view of *Eldering 129* and yet further in view of *Saam*. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims. In light of the amendments and discussion presented herein and the exhibits and declarations submitted herewith Applicant submits that these rejections are moot.

Independent Claim 1

[0027] In light of the evidence submitted and requested removal of *Zigmond* as a prior art reference, Applicant asserts that the remaining references do not disclose, teach, or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claims 12, 24, and 26

[0028] Applicant submits that each of these independent claims as amended recites at least one similar element to those recited in claims 1, 2, and 4-11, 24, and 25 for which the Office Action relies on *Zigmond* in its rejections. In light of the evidence submitted and removal of *Zigmond* as a prior art reference, Applicant asserts that the remaining references do not disclose, teach, or suggest all of the elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejections of these claims.

Dependent Claims 2, 4-11, 13-19, 21, 22, 25, 27, and 28

[0029] These claims ultimately depend upon one of independent claims 1, 12, 20, 24, and 26. As discussed above, claims 1, 12, 20, 24, and 26 are allowable over the cited documents. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable over the cited documents. Additionally, some or all of these claims may also be allowable for additional independent reasons. Applicant respectfully requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

New Claims 29 and 30

[0030] These claims depend upon one of independent claims 1 and 24. As discussed above, claims 1 and 24 are allowable over the cited documents. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable over the cited documents. Additionally, some or all of these claims may also be allowable for additional independent reasons. Applicant respectfully requests that the Examiner recognize claims 29 and 30 as allowable.

New Independent Claim 31

[0031] New independent claim 31 recites similar subject matter as claim 24 presented in a different statutory class. Claim 31 is asserted allowable for at least similar reasons as discussed above regarding claim 24 and may also be allowable for additional independent reasons. Applicant respectfully requests that the Examiner recognize claim 31 as allowable.

Dependent Claims

[0032] In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

Conclusion

[0033] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC
Representatives for Applicant

/Bea Koempel-Thomas 58213/

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